

ESTTA Tracking number: **ESTTA764189**

Filing date: **08/12/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92063729
Party	Plaintiff Ubiquiti Networks, Inc.
Correspondence Address	CYNTHIA R ADWERE LAW OFFICE OF CYNTHIA R ADWERE 2625 MIDDLEFIELD ROAD #360 PALO ALTO, CA 94306 UNITED STATES cynthia@adwerelaw.com
Submission	Opposition/Response to Motion
Filer's Name	Cynthia R. Adwere
Filer's e-mail	cynthia@adwerelaw.com
Signature	/Cynthia R. Adwere/
Date	08/12/2016
Attachments	Response to Motion to Dismiss.pdf(1705682 bytes)

Ubiquiti Networks, Inc.,

Cancellation No. 92,063,729

Apple Inc.,

Registrant.

Petitioner, Ubiquiti Networks, Inc. (“Ubiquiti”), hereby responds to Registrant Apple Inc.’s (“Apple”) Motion to Dismiss for the above-identified cancellation action.

Registrant's motion focuses on Ubiquiti's alleged failure to allege evidentiary "facts" to support the claims in its Petition for Cancellation ("Petition"), namely that: i) Apple *never* used the FRONT ROW mark in connection with hardware; ii) Apple had abandoned its FRONT ROW mark at the time the §§ 8 & 15 Declaration was filed; iii) Registration No. 3,411,726 ("Reg. '726") was fraudulently obtained by Apple's knowing false statement regarding use of the mark in connection with hardware; and iv) Reg. '726 was fraudulently maintained by Apple's knowing false statements in its §§ 8 & 15 Declaration regarding the use of the FRONT ROW mark from July 2011 through June 4, 2013.

However, Ubiquiti has no need to plead the proof of its case-in-chief in its Petition. Indeed, the TMBP specifically requests that parties not do so. *See* TMBP § 309.03(a)(2) (“*Evidentiary matters...should not be pleaded in a complaint. They are matters for proof, not for pleading.*”). Cancellations, as with other initial pleadings before the Board, are “notice” pleadings. The only requirement is that the pleading give “a short and plain statement of the ground(s) for cancellation” sufficient to give registrant “fair notice of the basis for each claim”. *See* TMBP § 309.03(a)(2). The fact that Apple has mounted a vigorous defense regarding its alleged continuous use of the FRONT ROW mark and the adequacy of its specimens of use makes it clear that Ubiquiti’s pleadings have given Apple ample “fair notice” of the bases of Ubiquiti’s claims.

II. Hardware Goods

Apple claims that Ubiquiti offers no “proof” that the FRONT ROW mark was never used in connection with hardware goods and that Ubiquiti has offered no facts in connection with its claim. Of course, Ubiquiti is not required to offer “proof” at this stage of the proceedings. It is merely required to offer “a short and plain statement of the ground(s) for cancellation”. Ubiquiti cannot unilaterally prove a negative. However, the USPTO file associated with Reg. ‘726 shows no proof that the mark was ever used in connection with “remote controllers for audio devices, video devices and personal computers”.¹ The submitted specimen references FRONT ROW software and “the Apple Remote”. Moreover, Apple deleted the hardware goods from its §§ 8 & 15 Declaration. These claims and sufficient supporting facts are laid out in Ubiquiti’s Petition and are adequate to support its claims.

¹ Ubiquiti acknowledges that since Apple offered a specimen supporting the claimed Cl. 9 software goods, no specimen supporting the claimed Cl. 9 hardware goods was required. However, contrary to Apple’s assertion, the specimen does *not* support use of hardware goods in connection with the mark.

III. Abandonment

Based on contemporaneous articles in legitimate, Apple-friendly publications, it was public knowledge that Apple discontinued its FRONT ROW software product with the release of its OS X 10.7 Lion software in July of 2011. Apple's specimen in support of its §§ 8 & 15 Declaration shows a photograph (not a screenshot) of a laptop running the FRONT ROW software. However, the operating system appears to be one of the versions prior to the OS X 10.7 Lion release. There is nothing to indicate that Apple was selling or distributing the FRONT ROW software in June of 2013, at the time the §§ 8 & 15 Declaration was filed. Again, Ubiquiti is not required to "prove a negative" in its pleadings. Public information indicates that the FRONT ROW software was discontinued, and there is no evidence in the Reg. '726 file or public record that suggests the mark was in use in June of 2013.

While Apple asserts that the software is *currently* being distributed by Apple, the webpage listed by Apple showing the FRONT ROW product for sale does not appear to have existed prior to July 19, 2015 (years *after* Apple filed its §§ 8 & 15 Declaration); and the support page listed by Apple is not evidence that the mark was in use with software. However, Apple's unsupported claims are a matter for trial. At the present, Ubiquiti has met its pleading requirements with regard to its abandonment claim.

IV. §§ 8 & 15 Declaration

As noted above, Ubiquiti has pleaded specific facts upon which it has rested its claims that the FRONT ROW mark was not in use at the time Apple filed its §§ 8 & 15 Declaration. If the mark was not in use at the time the Declaration was filed, then the Declaration was defective and Reg. '726 should have been canceled for non-use. In reviewing the adequacy of Ubiquiti's

Petition, the Board is to treat the pleaded facts as true. *See* TMBP § 503.02. Thus, Ubiquiti has met the pleading standard for cancellation on the basis of a defective § 8 Declaration.

V. Fraud

Apple alleges that Ubiquiti has not pleaded fraud with sufficient particularity to state a claim upon which relief should be granted. Ubiquiti concurs that under *In re Bose Corp.*, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009), Apple must have knowingly made a false, material representation of fact in connection with its application/declaration. However, neither *Bose* nor any of the other cases cited by Apple require “magic words” in the pleadings to meet that standard. As noted above, Ubiquiti has pleaded sufficient facts to support its claims that the statements regarding use of the FRONT ROW mark in connection with the hardware goods listed in the application resulting in Reg. ‘726, and in connection with the use of the mark in connection with software at the time the §§ 8 & 15 Declaration was filed, were false.

The declaration that a mark is in use with the listed goods is not only material, it is *essential* to obtain and maintain a registration. *See, e.g., Torres v. Torresella*, 1 U.S.P.Q.2d 1483 (Fed. Cir. 1986). Apple looks to *Exergen Corp. v. Wal-mart Stores, Inc.* as authority for its allegation that materiality must be specifically pleaded. 91 U.S.P.Q.2d 1656 (Fed. Cir. 2009). But the facts in *Exergen* do not support this reading. *Exergen* involved an allegation of inequitable conduct in a patent application. *See Exergen*, 91 U.S.P.Q.2d 1656. In patent prosecution, secondary documents regarding prior use are required to be filed. *Exergen* holds that it is not sufficient to allege that the applicant knew of and did not submit such evidence of prior use, but that the petitioner must also prove that the applicant had reason to know that the missing document (one among the many) was material. 91 U.S.P.Q.2d 1656. In a trademark application, there are no

such secondary documents filed as part of the application. Instead, there are four statements in the application; and they are all *essential* (and by definition “material”), namely that: i) the mark is in use with *all* the stated goods; ii) the mark has been in use in commerce since the date listed; iii) the specimen(s) is currently in use in commerce; and iv) Applicant believes itself to be the owner of the mark. Likewise, a §§ 8 & 15 Declaration contains only four statements; and they are all essential (and by definition “material”), namely that: i) the specimen(s) is currently in use in commerce; ii) the mark is *currently in use in commerce*; iii) the mark has been in *continuous* use for the past five years; and iv) registrant is unaware of any pending or final decision adverse to registrant’s claim of ownership. Under these circumstances, Apple’s assertion of a requirement that Ubiquiti include the magic word “material” in its Petition to describe Apple’s false claims of use is spurious. Likewise, Apple’s claim that Ubiquiti’s use of the “upon information and belief” pleading language somehow negates the pleaded claim(s) is ridiculous.

Finally, Apple asserts that Ubiquiti has failed to meet the fraud pleading standard with regard to willfulness. Ubiquiti has used the requisite language to plead the claims. Ubiquiti has also alleged the specific facts to which it has access without discovery to support its claims. That is all that is required under notice pleading and *Bose*, 91 U.S.P.Q.2d 1938. As noted above, it appears that Apple has never used the FRONT ROW mark in connection with hardware; and reputable, public sources indicate that Apple discontinued use of the FRONT ROW mark in July of 2011. If these facts were known by the public, it is not unreasonable to assume that they were also known by Apple. Since all pleaded facts are to be taken as true for purposes of this motion, Ubiquiti has met its burden.

Furthermore, Ubiquiti notes that in *Bose*, the declaration in question was signed by Bose Corporation’s General Counsel, Mark Sullivan. Mr. Sullivan understood that certain claimed

goods were no longer being sold by Bose Corporation in connection with the WAVE mark. However, Mr. Sullivan, assumedly unversed in trademark law and USPTO procedure, testified that he erroneously assumed that the repair and warranty work being performed in connection with the listed goods was sufficient use to maintain the registration. Thus, the court ruled that there was no evidence of an intent to deceive. *See Bose*, 91 U.S.P.Q.2d 1938. In contrast to *Bose*, both the application declaration and the §§ 8 & 15 Declaration for Reg. ‘726 were signed by *trademark counsel* for Apple. Ubiquiti further notes that when the Reg. ‘726 application was signed, the *Medinol* decision was the controlling precedent. *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205 (TTAB 2003). It is incredulous that trademark counsel could miss or mistake what constituted use of a trademark in connection with all of the listed goods, especially in light of the *Medinol* decision. Likewise, the continuing discussion of fraud after the *Bose* decision issued also strains credulity as to Apple’s trademark counsel’s ability to mistake what constituted use of a trademark sufficient to support a §§ 8 & 15 Declaration. But proof of this matter is not appropriately addressed in this motion. This is a matter for discovery and trial.

Ubiquiti acknowledges that there are issues of fact in question in this proceeding that will require proof by evidence. That evidence will be properly discovered, vetted and submitted at the appropriate times in this proceeding. Ubiquiti has met the Board’s pleading standard by giving Apple a “short and plain statement of the ground(s) for cancellation” sufficient to give Apple fair notice of the bases of Ubiquiti’s claims; and Ubiquiti has alleged facts that, if taken as true, would support Ubiquiti’s claims. Apple’s Motion to Dismiss is nothing more than a disingenuous attempt to short circuit the trial and skip discovery, simply based on their own unsubstantiated and self-serving claims. Resumption of this proceeding will allow Ubiquiti to submit its evidence as Apple demands.

For the foregoing reasons, Ubiquiti Networks, Inc. hereby requests that Apple Inc.'s Motion to Dismiss be denied.

Respectfully submitted,

Date: 8/12/16

[Signature]

Cynthia R. Adwere
Lisa A. Garono
Law Office of Cynthia R. Adwere
Attorney for Petitioner

Law Office of Cynthia R. Adwere
2625 Middlefield Rd # 360
Palo Alto, California 94306-2516
Telephone: 650-346-5750
cynthia@adwerelaw.com
File No.: UBN-762

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Response to Registrant's Motion to Dismiss has been served on Registrant by mailing said copy on date shown below, *via* United States Postal Service as first class mail, postage prepaid, in an envelope addressed to:

GLENN A GUNDERSEN
DECHERT LLP
CIRA CENTRE 2929 ARCH ST
PHILADELPHIA, PA 19104-2808
UNITED STATES

Executed this 12th day of August, 2016.

[Signature]